

REMARKS

Status of the Claims.

Claims 1-9, 12-18, and 20-26 are pending with entry of this amendment, claims 10, 11, and 19 being cancelled and no claims being added herein. Claims 1, 6, 9, 12-18, and 21-26 are amended herein. These amendments introduce no new matter. Support is replete throughout the specification (*e.g.*, in the claims as originally filed).

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22798

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35 U.S.C. §112, Second Paragraph.

Claims 1-9, 12-18, and 20-26 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite because of the phrase "synergistic combination". The claims are amended herein to eliminate the term "synergistic combination" thereby obviating this rejection.

35 U.S.C. §103(a).

Claims 1-6, 9, 12-14, 16-18, 20-23, and 25-26 were rejected under 35 U.S.C. §103(a) as allegedly obvious in light of Yu *et al.* (U.S. Patent 5,385,938), in view of Poli *et al.* (1979) *Food Chemistry*, 4(3): 251-258, Wenninger (International Cosmetic Ingredient Dictionary and Handbook, 7th Ed., 1: 163-168, and Merck Index 11th ed. (1989) Glycolic acid monograph 4394, page 439. According to the Examiner, Yu *et al.* teaches a topical composition with glycolic acid as the active ingredient and ethanol as the solvent. Poli *et al.* is cited as allegedly teaching that glycolic acid is virucidal against herpesvirus. Wenninger is cited as allegedly teaching that butylenes glycol is useful as a solvent in numerous cosmetic marketed products. The Merck index allegedly teaches that the pH of 0.5% glycolic acid solution is 2.50. Applicants traverse.

The Examiner is respectfully reminded that *prima facie* case of obviousness requires that the combination of the cited art, taken with general knowledge in the field, must provide all of the elements of the claimed invention. When a rejection depends on a combination of prior art references, there must be some **teaching, suggestion, or motivation to combine** the references. *In re Geiger*, 815 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Moreover, to support an obviousness rejection, the cited references must additionally **provide a reasonable expectation of success**. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991), *citing In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

In addition, the Examiner is also reminded that the MPEP expressly states that "**if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification**". MPEP §2143.01, *citing In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

In the instant case, modification of the compositions of Yu *et al.* would make the formulation unsatisfactory for Yu *et al.*'s intended purpose. Moreover, Yu *et al.* expressly teach away from the presently claimed formulation. In particular, Yu *et al.* teach the use of compositions containing **both**:

- 1) an **amphoteric or pseudoamphoteric** compound; and
- 2) **alpha hydroxyacids, alpha ketoacids** or related compound.

Thus, for example, Yu *et al.* expressly states:

It has now been discovered that **amphoteric compositions** containing alpha hydroxyacids, alpha ketoacids or related compounds, and also the compositions containing dimeric or polymeric forms of hydroxyacids overcome the aforementioned shortcomings and retain the therapeutic efficacies for cosmetic conditions and dermatologic disorders. **The amphoteric composition contains in combination an amphoteric or pseudoamphoteric compound and at least one of the alpha hydroxyacids, alpha ketoacids or related compounds.** [emphasis added] (col. 3, lines 10-12).,

The amphoteric composition of the instant invention contains in combination an **alpha hydroxyacid or alpha ketoacid and an amphoteric or pseudoamphoteric compound**. [emphasis added]

This is illustrated by Example 1 (col. 14, lines 1-10) which states:

An amphoteric composition containing 1M 2-hydroxyethanoic acid and 0.5M L-arginine in solution form for dandruff or dry skin may be formulated as follows.

2-Hydroxyethanoic acid (glycolic acid) 7.6 g is dissolved in water 60 ml and propylene glycol 20 ml. L-Arginine 8.7 g is added to the solution with stirring until all the crystals are dissolved. Ethanol is added to make a total volume of the solution to 100 ml. The amphoteric composition thus formulated has pH 3.0. An amphoteric composition formulated from 1M 2-hydroxyethanoic acid and 1M L-arginine has pH 6.3. The solution has pH 1.9 if no amphoteric compound is incorporated. [emphasis added]

In this instance, 2-hydroxyethanoic acid is the alphahydroxy acid, while L-arginine is the amphoteric compound. See, e.g., col.5, lines 1-7 which state:

The representative amphoteric compounds of amino acid type may be listed as follows: Glycine, alanine, valine, leucine, isoleucine, serine, threonine, cysteine, cystine, methionine, aspartic acid, asparagine, glutamic acid, glutamine, arginine, lysine, 5-hydroxylysine, histidine, phenylalanine, tyrosine, tryptophan, 3-hydroxyproline, 4-hydroxyproline and proline. [emphasis added]

Elimination of the L-arginine (the amphoteric compound) to produce a composition consisting of glycolic acid and ethanol would defeat the central teaching of the Yu et al. patent. Moreover, Yu *et al.* expressly teaches that in the absence of the amphoteric compound, the solution has a pH of 1.9 which is lower than the pH of 2.45 to 4.5 recited in the pending claims.

Yu *et al.* thus, by teaching the necessity of an amphoteric or pseudoamphoteric compound, expressly leads one of skill away from the presently claimed invention. Moreover, elimination of the amphoteric compound would defeat the central teaching of Yu *et al.* and render their compounds unsuitable for the intended use.

Yu *et al.* thus fails to teach or suggest the presently claimed invention and expressly teaches away. The defects of Yu *et al.* are not remedied by Poli *et al.* Wenninger, the Merck Index, or Pamukoff.

For example, Poli *et al.* allegedly teaches that glycolic acid is virucidal against herpesvirus in culture. Poli *et al.* offers no teaching or suggestion of preventing virus-induced lesions.

In addition, Poli *et al.* offers no teaching or suggestion of the combination of glycolic acid and an alcohol as presently claimed. Moreover combination of the teaching of Poli *et al.* with Yu *et al.* to produce the presently claimed method would still require elimination of the amphoteric compound and thus render the compounds of Yu *et al.* unsuitable for their intended use.

The Merck index, cited by the Examiner expressly states:

Use: In the processing of textiles, leather, and metals; in pH control, and wherever a cheap organic acid is needed, *e.g.*, in the manuf of adhesives, in copper brightening, decontamination cleaning, dyeing, electroplating, in pickling, cleaning and chemical milling of metals. **Caution: Mild irritant to skin, mucous membranes.**

By teaching that glycolic acid is an irritant, the Merck index leads one of skill away from the use of glycolic acid in topical applications, **particularly for the prevention of lesions as recited in the pending claims.** The combination of Yu *et al.*, Poli *et al.*, and/or the Merck Index, simply offers no teaching or suggestion of the presently claimed invention and, in fact teaches away from such an invention.

The defects of these references are not remedied by Wenninger. Wenninger teaches that butylene glycol is found in a number of skin care products. Wenninger further teaches that butylene glycol is a viscosity increasing agent. Wenninger offers no teaching or suggestion that butylenes glycol functions is useful in preventing virus-induced lesions.

The cited references alone, or in combination thus fail to teach or suggest the presently claimed invention. Moreover, by teaching the **necessary inclusion of an amphoteric or pseudoamphoteric** compound (Yu *et al.*), and by teaching that glycolic acid is an **irritant of skin** and mucous membranes (Merck Manual), the combination of references expressly lead one of skill away from the presently claimed method. Moreover the combination of references offer no teaching whatsoever regarding the prevention of lesions as recited in the pending claims. Accordingly the Examiner has failed to make his *prima facie* case and the rejection of claims 1-6, 9, 12-14, 16-18, 20-23, and 25-26 under 35 U.S.C. §103(a) should be withdrawn.

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is

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respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3513.

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Respectfully submitted,



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